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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,461	12/12/2003	Bonnie M. Pemberton	31960.0104	9697

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EXAMINER

OSELE, MARK A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/734,461

Applicant(s)

PEMBERTON ET AL.

Examiner

Mark A Osele

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 5,6 and 16-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,7-15 and 42-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I in the reply filed on December 27, 2004 is acknowledged. The traversal is on the ground(s) that the article cannot be used in a different method from the claimed method because claim 1 states the strips are "adapted to be....adhered to said home furnishing." This is not found persuasive because this language is merely intended use and not given patentable weight. Tape adapted to be adhered to home furnishings is no different from tape adapted to be adhered to a wall.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 42-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Sekula. Sekula shows double sided adhesive tape releasably adhered to a corrugated substrate, 26, on the first adhesive surface, 22, and having a release layer, 28, adhered on the second adhesive surface, 24 (column 2, lines 25-34).

Regarding claim 43, Sekula teaches that the substrate can be plastic (column 3, lines 23-29.)

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Italian Patent 590,156 (Avery Adhesive) in view of Patel et al. Avery Adhesive shows the construction of double sided adhesive tapes, 11, on a continuous backing release layer, 20, with individual release sheets, 10, overlying the individual tapes (See Figs. 1, 3). Avery Adhesive fails to show the claimed water soluble adhesive.

Patel et al. teaches that double sided adhesive tapes with water soluble adhesive are conventional for attaching objects to fabric (column 1, lines 51-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use any conventional double sided adhesive tape such as the one shown by Patel et al. dependent upon the desired use of the tape.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Italian Patent 590,156 (Avery Adhesive) in view of Patel et al. as applied to claim 1 above, and further in view of Sato. The references as combined fail to disclose gaps between the individual double sided adhesive tapes.

Sato teaches that cutting labels on a backing sheet to create gaps between the individual labels allows for easier separation from the backing sheet than the prior art

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(column 5, lines 20-24; column 5, lines 68 to column 6, line 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to space the individual double sided adhesive tapes of the references as combined in the manner of Sato because Sato teaches the spacing to aid in label release. In addition, it would have been obvious to one of ordinary skill in the art that spaced individual adhesive tapes could be more easily removed by hand.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Italian Patent 590,156 (Avery Adhesive) in view of Patel et al. as applied to claim 1 above, and further in view of Anhauser et al. The references as combined fail to show a slit in the backing layer. Anhauser et al. teaches that it is known to provide linear cuts in the backing layer protecting adhesive to aid in removal of the backing material into two pieces (column 1, lines 54-60). Anhauser et al. further shows an elongate adhesive label with a lengthwise slit in the protective layer (Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a lengthwise slit in the cover layer of the references as combined because Anhauser et al. teaches the value in such a slit for separating and peeling a cover sheet from an adhesive layer.

8. Claims 7, 9, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Italian Patent 590,156 (Avery Adhesive) in view of Anhauser et al. Avery Adhesive shows the construction of double sided adhesive tapes, 11, on a continuous backing release layer, 20, with individual release sheets, 10, overlying the individual tapes (See

Figs. 1, 3). Avery Adhesive fails to show the release layer including a cut that divides the release layer into two sections.

Anhauser et al. teaches that it is known to provide linear cuts in the backing layer protecting adhesive to aid in removal of the backing material into two pieces (column 1, lines 54-60). Anhauser et al. further shows an elongate adhesive label with a lengthwise slit in the protective layer (Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a lengthwise slit in the cover layer of Avery Adhesive because Anhauser et al. teaches the value in such a slit for separating and peeling a cover sheet from an adhesive layer.

Regarding claim 9, Avery Adhesive shows the plurality of strips arranged side by side on the transfer sheet.

Regarding claim 12, Anhauser et al. shows the slit can be widthwise as well as lengthwise (See Figs. 3 and 4).

Regarding claim 13, double sided adhesive strips are typically transparent.

9. Claims 7, 11, 13-15, and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekula in view of Anhauser et al. Sekula shows double sided adhesive tape releasably adhered to a corrugated substrate, 26, on the first adhesive surface, 22, and having a release layer, 28, adhered on the second adhesive surface, 24 (column 2, lines 25-34). Sekula fails to show the release layer including a cut that divides the release layer into two sections.

Anhauser et al. teaches that it is known to provide linear cuts in the backing layer protecting adhesive to aid in removal of the backing material into two pieces (column 1, lines 54-60). Anhauser et al. further shows an elongate adhesive label with a lengthwise slit in the protective layer (Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a lengthwise slit in the cover layer of Sekula because Anhauser et al. teaches the value in such a slit for separating and peeling a cover sheet from an adhesive layer.

Regarding claim 13, double sided adhesive strips are typically transparent.

Regarding claims 14 and 15, the strip of Sekula is substantially the same length and width as the transfer sheet.

Regarding claim 44, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a colored substrate because colored and printed substrates are commonly used for identification and advertising purposes.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Italian Patent 590,156 (Avery Adhesive) in view of Anhauser et al. as applied to claim 7 above, and further in view of Sato. The references as combined fail to disclose gaps between the individual double sided adhesive tapes.

Sato teaches that cutting labels on a backing sheet to create gaps between the individual labels allows for easier separation from the backing sheet than the prior art (column 5, lines 20-24; column 5, lines 68 to column 6, line 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to space

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the individual double sided adhesive tapes of the references as combined in the manner of Sato because Sato teaches the spacing to aid in label release. In addition, it would have been obvious to one of ordinary skill in the art that spaced individual adhesive tapes could be more easily removed by hand.

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Italian Patent 590,156 (Avery Adhesive) in view of Anhauser et al. as applied to claim 7 above, and further in view of Patel et al. The references as combined fail to show the claimed water soluble adhesive.

Patel et al. teaches that double sided adhesive tapes with water soluble adhesive are conventional for attaching objects to fabric (column 1, lines 51-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use any conventional double sided adhesive tape such as the one shown by Patel et al. dependent upon the desired use of the tape.

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

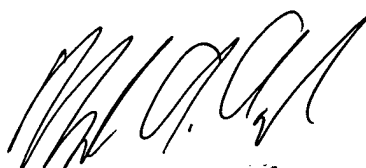
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone



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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Mark A. Osele', is positioned above the printed name and title.

**MARK A. OSELE**  
**PRIMARY EXAMINER**

March 2, 2005